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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,822	09/16/2003	Javit A. Drake	08935-297001 / M-5031	3431
26161	7590	06/04/2009	EXAMINER	
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			HODGE, ROBERT W	
		ART UNIT	PAPER NUMBER	
		1795		
		NOTIFICATION DATE	DELIVERY MODE	
		06/04/2009	ELECTRONIC	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/664,822	DRAKE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	ROBERT HODGE	1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 13 April 2009.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 11-39 is/are pending in the application.  
 4a) Of the above claim(s) 34-39 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 11-33 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____.   | 6) <input type="checkbox"/> Other: _____ .                        |

## DETAILED ACTION

### ***Response to Arguments***

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Applicant's arguments with respect to claims 11-33 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 11-23 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The location and orientation of the composite membrane within the housing is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). As recited claim 11 only recites that the composite membrane resides in the housing but does not recite any specific location or orientation within the housing. In the appeal brief filed 4/13/09 in the Summary of Claimed Subject Matter applicants show the criticality of the location and orientation of the multilayer membrane specifically with regards to the embodiment illustrated in Figure 2B, which is described as being the representative embodiment recited in the claims. Currently there is no recitation in any of claims 11-23 that clearly depicts the

specific location and orientation of the composite membranes as illustrated in the embodiment of Figure 2B. As currently recited the composite membrane can be located and oriented anywhere within the fuel cartridge, including but not limited to covering the fuel egress port and if the composite membrane does cover the fuel egress port than the instantly claimed invention cannot and will not function because of the methanol-impermeable layer of the composite membrane that will prevent the methanol from permeating out of the fuel cartridge.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11-23 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claims 11-23 fail(s) to correspond in scope with that which applicant(s) regard as the invention can be found in the reply filed 4/13/09. In that paper, applicant has stated that figure 2B represents the embodiment that is recited in the above listed claims, and this statement indicates that the invention is different from what is defined in the claim(s) because claim 11 only recites that the composite membrane resides in the housing but does not recite any specific location or orientation within the housing.

Claims 11-23 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: specific location and orientation of the composite membrane within the fuel cartridge housing.

***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 24-30, 32 and 33 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 5,069,793 hereinafter Kaschemekat.

Kaschemekat teaches a spirally wound multi layer composite membrane comprising a porous substrate (i.e. web), a membrane disposed on a first surface of the substrate (i.e. microporous substrate membrane) and a coating that is a permselective polymer on the other surface of the substrate and said multi layer composite membrane can be a plurality of membranes (column 1, lines 11-52, column 10, lines 33-64 and example 1). Kaschemekat further teaches that the permselective polymer coating is chosen for their specific selectivity. It is submitted that due to the breadth of the recitation in claims 28 and 33 of "other analogous polymers or composites", the polyester support web falls within said genus and the burden is shifted to applicants to prove in the form of evidence otherwise. It is also submitted that due to the breadth of the recitation in claims 29 and 33 of "polyurethanes" and "polymeric composition and composites" the asymmetric Loeb-Sourirajan type membrane falls within said genus and the burden is shifted to applicants to prove in the form of evidence otherwise. It is further submitted that due to the breadth of the recitation in claims 32 and 33 of "polymer/inorganic composite" or "other methanol-impermeable material" at least polysilicone-carbonate copolymers and fluoroelastomers fall within said genus' as well

as other listed materials found in the Markush group in column 10 of Kaschemekat and the burden is shifted to applicants to prove in the form of evidence otherwise.

In the alternative it would have been obvious to one having ordinary skill in the art to select the permselective polymer coating based on its specific selectivity since there are a finite number of identified, predictable solutions identified in Kaschemekat and Kaschemekat specifically teaches that the permselective polymer coating is chosen based on its specific selectivity. See MPEP 2141 (III) Rationale E, KSR v. Teleflex (Supreme Court 2007).

#### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaschemekat as applied to claim 24 above, and further in view of U.S. Patent No. 6,207,369 hereinafter Wohlstadter.

Kaschemekat does not teach that the membrane is a sintered metal coated with a polymer.

Wohlstadter teaches that filters may comprise sintered metals coated with polymer membranes (column 70, line 66 – column 71, line 4).

At the time of the invention it would have been obvious to one having ordinary skill in the art to include a sintered metal coated with a polymer as the membrane for Kaschemekat as taught by Wohlstadter in order to increase the overall rigidity of the

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composite membrane thus making it more durable and also since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT HODGE whose telephone number is (571)272-2097. The examiner can normally be reached on 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert Hodge/  
Examiner, Art Unit 1795